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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/953,154	10/17/1997	KEITH A. KOZAK	450.154US1	3463

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EXAMINER

VORTMAN, ANATOLY

ART UNIT PAPER NUMBER

2835

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 08/953,154	Applicant(s) KOZAK ET AL.	
	Examiner Anatoly Vortman	Art Unit 2835	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 4 February'05 (Reply under 35 CFR 1.111).
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11,13-18,20,21,29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11,13-17,20,21,29 and 30 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Amendment*

1. The submission of the amendment filed on 02/04/05 is acknowledged. At this point, claims 1, 2, 6, 14, 18 are amended, claims 12, 19, and 22-28 are canceled, and new claims 29 and 30 are added. Thus, claims 1-11, 13-18, 20, 21, 29, and 30 are pending in the instant application.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 29 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "major surface" renders claims indefinite, since there is no definition in the specification for the "major surface". It is not clear which surface of the device the Applicant considers to be a "major surface" and in which respect (i.e. the surface with the largest area or the surface which is most important for the functioning of the device, or the surface having any other properties, which would render said surface a "major" one).

*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-5, are rejected under 35 U.S.C. 102(b) as being anticipated by US/5,268,675 to Garthwaite et al., (Garthwaite).

Regarding claim 1, Garthwaite disclosed (Fig. 1-6C) a keyboard (3) comprising: a housing defining a non-integral personal computer keyboard; a plurality of keys disposed within the housing; a communications link disposed within the housing, wherein the communications link is capable of communicating with a remote computer (column 3, lines 52+); and, a connector (52) operatively coupled to the communications link, said connector (52) being

disposed within the housing and being receptive to a corresponding connector (22) of a device (10) such that the device (10) communicates with the computer over the communications link when the connectors are coupled.

Regarding claims 2-4, Garthwaite disclosed that the housing has a plurality of surfaces (54) defining a cradle cavity (50) into which the connector (52) is disposed, the cradle cavity (50) shaped so that the device (10) fits into the cavity such that at least one surface (top and / or front) of the device is exposed.

Regarding claim 5, Garthwaite disclosed that the housing has an end surface into which the connector is disposed (52), the connector (22) of the device (10) coupling the connector of the housing (52) such that at least a top surface of the device (10) is flush with a corresponding surface of the housing (Fig. 7C, when said device (10) is positioned perpendicularly to the supporting surface, (i.e. at the 90° angle to the top surface of the keyboard)).

7. Claims 17, 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by US/5,835,732 to Kikinis et al.

Regarding claim 17, Kikinis disclosed (Fig. 20) a keyboard (151) comprising: a housing defining a non-integral personal computer keyboard; a plurality of keys disposed within the housing; a communications link disposed within the housing to communicatively couple the keyboard to the computer; and, a communications link disposed within the housing, wherein the communications link is capable of communicating with a computer (inherently, the link connects device (10) to a computer via keyboard); and, a connector disposed within the housing (inherently, for connecting cable (153) to the keyboard's circuitry) and receptive to a

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corresponding connector (the connector of the device (10) which accepts the plug (20)) of a personal digital assistant (PDA) device (10) such that the PDA device (10) communicates with the computer over the communications link when the connectors are coupled.

Regarding claim 20, Kikinis disclosed (Fig. 20) a computer keyboard (151) comprising: a housing defining a non-integral personal computer keyboard; a plurality of keys disposed within the housing; a communications link disposed within the housing, wherein the communications link is capable of communicating with a computer (inherently, the link connects device (10) to a computer via keyboard), and a connector disposed within the housing (inherently, for connecting cable (153) to the keyboard's circuitry) and receptive to a corresponding connector (the connector of the device (10) which accepts the plug (20)) of a device (10) having a touch screen (16), (column 4, lines 56+), such that the device (10) communicates with the computer over the communication link when the connectors are coupled.

Regarding claim 21, Kikinis disclosed that the housing has an end surface into which the connector is disposed (inherently, for connecting cable (153) to the keyboard's circuitry), the connector (20) of the device (10) coupling the connector of the housing such that at least one of a top surface and a bottom surface of the device (10) is flush with the corresponding surface of the housing (since cable (153) is flexible, the device (10) may be positioned such that it's top or bottom surface may be flash with the surface of the keyboard).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6-11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garthwaite in view of Kikinis ('732).

Regarding claims 6-8, and 13, Garthwaite disclosed all, but that the communication link comprises at least a cable (USB-compatible cable) and / or a transceiver.

Kikinis disclosed (Fig. 1-6) a computer system with a keyboard (60) having communication link (26') for communicating with the computer system, wherein said communication link (26') may be implemented as a serial cable or wireless transceiver (column 1, lines 37+).

Since inventions of Garthwaite and of Kikinis are from the same field of endeavor (computer systems), the purpose of the serial cable and wireless receiver disclosed by Kikinis may be recognized in the invention of Garthwaite.

It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to implement said communication link of Garthwaite with serial (USB) cable and / or wireless receiver, in order to provide plug-and-play capabilities and to enhance convenience for a user.

Regarding claims 9, 10, and 15, Kikinis disclosed a power source operatively coupled to the connector (14') of the keyboard to recharge a battery (15) of the device (10), (column 6, lines 3+).

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Regarding claim 11, Kikinis disclosed that said device (10) is a PDA, operable in a docking mode or stand-alone mode (column 4, lines 46+; column 6, lines 3+).

Regarding claim 14, Kikinis disclosed that said device (10) has a touch screen (16) having at least one virtual key that interacts with the computer (column 4, lines 56+).

Regarding claim 16, Kikinis disclosed that said device (10) is a telephone handset, (column 14, lines 27+).

### ***Allowable Subject Matter***

10. Claim 18 is allowed. Reasons for allowance have been presented in the previous non-final Office action.

### ***Response to Arguments***

11. Applicant's arguments filed on 02/04/05 have been fully considered but they are not persuasive.

The Applicant contends: "the keyboard 3 (of Garthwaite) is integral part of computer 1 and not a remote computer has claimed in claim 1...the keyboard is integrated with the remainder of the computer" (see p. 1 of the Amendment, lines 14+). The aforementioned Applicant's position is not understood. Fig. 1 of Garthwaite shows a "typical computer" (see column 3 of Garthwaite, lines 31+) having a standalone non-integral keyboard (3) positioned in front of the computer housing (2). The Examiner would like to direct the Applicant's attention to



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the Fig. 1 of the instant application, which depicts the same type of computer. The only difference is that the keyboard of Garthwaite is positioned directly in front of the computer housing instead of at the side of the computer housing, as shown on Fig. 1 of the instant application. Naming the keyboard of Garthwaite an “integrated” keyboard is simply incorrect. Had the computer of Garthwaite was an “all-in-one” computer or a portable one, than it would be appropriate to name the keyboard an “integrated” one.

Further, the Applicant’s position that Garthwaite did not disclose a “cradle” is also believed to be in error.

As stated in the outstanding rejection, “Garthwaite disclosed that the housing has a plurality of surfaces (54) defining a cradle cavity (50) into which the connector (52) is disposed, the cradle cavity (50) shaped so that the device (10) fits into the cavity such that at least one surface (top and / or front) of the device is exposed” (see outstanding non-final Office action, p. 3, last four lines).

The Academic Press Dictionary of Science and Technology, (Academic Press, Inc., 1992) (p. 540, left column) defines “cradle” as “*a framework that carries, supports, or restrains materials or engines*”, i.e. the “cradle” is generally defined the “support”. Thus, the aforementioned structure of Garthwaite is perfectly in line with the aforementioned definition, since it supports the device (10). Further, the claims 2-4 of the instant application do not specify that the entire device fits into the cradle cavity, but only generally state that device fits into the cavity. On Fig. 6A-6C of Garthwaite is shown that device (10) fits into the cavity (50) at list partially. Please note, that prongs (54) and the electrical connector are parts of the device (10).

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Further, the Examiner respectfully disagrees with the Applicant's interpretation of Fig. 7C (see Amendment, p. 2, lines 5+). The figure does show the device (10) positioned at an angle of 45°. But it would have been absolutely clear at the time the invention was made to a person of ordinary skill in the computer art, that if said device (10) would be turned perpendicularly to the upper surface of the keyboard (2) (i.e. at 90°), the upper surface of the device (10) would be flush with the side surface of said keyboard (2). It is well settled that "[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences (emphasis added) which one skilled in the art would reasonably be expected to draw therefrom." *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). "The test for an implicit showing (emphasis added) is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1338, 1342-44, 61 USPQ2d 1430.

Regarding the Applicant's arguments directed to the Kikinis reference, the Examiner believes that the Applicant has misinterpreted the rejection of claims 17, 20, and 21. It is not clear why the Applicant has named member (153) as the "connector" (see p. 2 of the Amendment, lines 22+). The Examiner had clearly stated in the outstanding rejection, that "a connector disposed within the housing (inherently, for connecting cable (153) (emphasis added) to the keyboard's circuitry)". As such the arguments regarding the Kikinis reference are believed to be moot.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 571-272-2047. The examiner can normally be reached on Monday-Friday, between 10:00 am and 6:30 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Lynn Feild can be reached on 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AV



Anatoly Vortman  
Primary Examiner  
Art Unit 2835